

RECEIVED
CENTRAL FAX CENTER

9194199354

1 / 3

OCT 18 2004

ATMI-537 CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:)	Docket No.:	ATMI-537 CIP (7496)	
Applicants:	XU, Chongying, et al.)	Conf. No.:	9371
Application No.:	10/632,009)	Art Unit:	2818
Date Filed:	July 31, 2003)	Examiner:	DANG, Phuc T.
Title:	SUPERCRITICAL FLUID- ASSISTED DEPOSITION OF MATERIALS ON SEMICONDUCTOR SUBSTRATES)	Customer No.:	25559

FACSIMILE TRANSMISSION CERTIFICATE


ATTN: Examiner Phuc T. DANG

Fax No. (703) 872-9306

I hereby certify that this document is being filed in the United States Patent and Trademark Office, via facsimile transmission to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 18, 2004, to United States Patent and Trademark Office facsimile transmission number (703) 872-9306.

3

Number of Pages (including cover)



Tristan A. Fuierer

October 18, 2004

Date

RESPONSE TO RESTRICTION REQUIREMENT IN SEPTEMBER 29, 2004 OFFICE
ACTION IN U.S. PATENT APPLICATION NO. 10/632,009

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

ATMI-537 CIP

In the September 29, 2004 Office Action, the Examiner imposed a restriction requirement against claims 1-108, and required that an election be made between:

Group I: claims 1-51, drawn to an apparatus of forming material on a substrate, classified in class 257, subclass E21-17;

Group II: claims 52-108, drawn to a method of forming a material on a substrate, classified in class 438, subclass 778.

Notably, Group I, claims 1-51 are not drawn to an apparatus of forming material on a substrate, but rather Group I, claims 1-51 are drawn to a deposition composition for depositing material on a substrate. Applicants respectfully request the Examiner acknowledge same.

Applicants hereby elect, with traverse, Group I claims 1-51 drawn to a deposition composition.

Although the Examiner failed to provide reasons to support the restriction requirement that are consistent with the correct identification of the claims, applicants still wish to respond to the restriction to advance the progress of prosecution of the present case.

The traversal is based on the fact that the restrictions are in error. The deposition composition recited in claim 1 is the same as that recited in method of use claim 52, insofar as the specifically recited components of the deposition composition are concerned, and thus claim 52 is not independent and distinct from claim 1, as is necessary under 35 U.S.C. § 121 as a basis for proper restriction.

It therefore is requested that the restriction requirements be reconsidered, and that all claims 1-108 be retained in consolidated form for further examination and prosecution on the merits.

If the restriction requirements nonetheless are made final, applicants alternatively request rejoinder of method claims 52-108 under the provisions of MPEP § 821.04 upon confirmation of allowable subject matter of the Group I claims 1-51.

ATMI-537 CIP

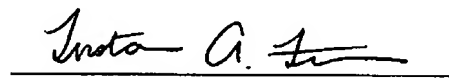
Such rejoinder would be fully proper under these circumstances for the following reasons.

When an application as originally filed discloses a product and the process for making and/or using such product, and only the claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product for examination through the rejoinder procedure in accordance with MPEP §821.04, provided that the process claims depend from or include all the limitations of the allowed product claims.

In the present application the elected claims 1-51 are directed to a deposition composition comprising a supercritical fluid and a precursor to be deposited on a substrate, and non-elected claims 52-108 are directed to a method of depositing said deposition composition on a substrate. Consistent with the provisions of the MPEP §821.04, when the product claims 1-51 are subsequently found allowable, the withdrawn method claims 52-108 should properly be rejoined for examination.

Respectfully submitted,


Marianne Fuierer
Reg. No. 39,983
Attorney for Applicants


Tristan A. Fuierer
Reg. No. 52,926
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
Phone: (919) 419-9350
Fax: (919) 419-9354
Attorney File No.: 2771-537 CIP (7496)